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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,223	02/16/2001	Loren Swingle	Verizon-6	4340

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EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,223

Applicant(s)

SWINGLE ET AL

Examiner

Olisa Anwah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 18-24 and 26-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 9 and 17 is/are allowed.
- 6) ☒ Claim(s) 7, 8, 14, 15 and 25 is/are rejected.
- 7) ☒ Claim(s) 10-13 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claim 7 is rejected under 35 U.S.C. § 102(e) as being anticipated by Wood et al, U.S. Patent Application Publication No. 2002/0111991 (hereinafter Wood).

Regarding claim 7, Wood discloses a method of operating a communications device (see Figure 1), the method comprising:

accessing a voice message system (see 260 from Figure 4);
retrieving, over a public telephone network, a voice message from the voice message system (see 266 from Figure 4);
generating a digital audio file representing said message (see 272 from Figure 4);

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sending, using at least one Internet Protocol (IP) packet, the digital audio file representing said message to a service subscriber (see 364 from Figure 6A);

receiving an E-mail message including a telephone number and an audio file (see Figure 6B); and

initiating a telephone call using said telephone number (see 424 from Figure 6E).

3. Claims 14, 15 and 25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tverskoy et al, U.S. Patent No. 6,341,160 (hereinafter Tverskoy).

Regarding claim 14, Tverskoy discloses a method of controlling a voice message system (see toll-free voice mail system from column 8, line 23), comprising:

receiving an E-mail message (see delete message command from column 6, line 13) indicating that a voice message (see Message 1 from column 6, line 19) retrieved from said voice message system and forwarded to a service subscriber was reviewed;

in response to receiving said E-mail message, accessing said voice message system and controlling said voice message system to delete said retrieved voice message (see column 6, lines 12-15).

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On the issue of claim 15, see column 1, lines 15-25.

Regarding claim 25, Tverskoy discloses a device for controlling a voice message system (see toll-free voice mail system from column 8, line 23), comprising:

means for receiving an E-mail message (see delete message command from column 6, line 13) indicating that a voice message (see Message 1 from column 6, line 19) retrieved from said voice message system and forwarded to a service subscriber was reviewed;

means for accessing said voice message system in response to receiving said E-mail message and means for controlling said voice message system to delete said retrieved voice message (see column 6, lines 12-15).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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5. Claim 8 is rejected under 35 U.S.C § 103(a) as being unpatentable over Tobias et al, U.S. Patent No. 6,732,151 (hereinafter Tobias) combined with Bannister et al, U.S. Patent No. 6,621,892 (hereinafter Bannister) in further view of Chan, U.S. Patent No. 6,925,166 (hereinafter Chan).

Regarding claim 8, Tobias discloses a method of operating a communications device, the method comprising:

- accessing a voice message system;
- retrieving, over a public telephone network, a voice message from the voice message system;
- generating a digital audio file representing said message;
- and
- sending, using at least one Internet Protocol (IP) packet, the digital audio file representing said message to a service subscriber (see abstract).

Tobias fails to teach:

- receiving an E-mail message including a telephone number and an audio file; and
- initiating a telephone call using said telephone number.

Nonetheless, Bannister discloses these limitations (see 216 from Figure 2A and 220 from Figure 2B). Therefore it would have

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been obvious to one of ordinary skill in the art to modify Bannister with the receiving and initiating steps shown by Bannister. This modification would have improved the convenience of Tobias by providing a system and method for converting an electronic mail message into audio or voice form for telephonic communication to a recipient as suggested by Bannister (see column 1, lines 40-50).

With further respect to claim 8, the combination of Tobias and Bannister does not explicitly explain:

monitoring to detect a speech signal followed by a period of silence; and

upon detecting said period of silence, playing the audio file.

Nonetheless, Chan discloses these limitations (see 104 and 108). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Tobias and Bannister with the monitoring and playing features of Chan. This modification would have improved the system's efficiency by detecting if the recipient's telephone line is busy, or there is no answer, or an

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answering machine answers the call as suggested by Bannister (see column 8, lines 10-15).

Response to Arguments

6. Applicant argues Tverskoy does not teach or suggest receiving an E-mail message indicating that a voice message retrieved from said voice message system and forwarded to a service subscriber was reviewed. Examiner respectfully disagrees. Tverskoy clearly explains the "delete message 1" command is sent in response to receiving a "Message 1" message (see column 6, lines 15-25). Tverskoy also indicates, "The command itself, including any required or optional arguments relating to the command, are contained in the body of the e-mail message". Thus, Tverskoy covers a scenario where the user can send a "delete message 1" command with a message body stating, "message 1 was reviewed". For this reason, the Examiner cannot allow claims 14 and 25 as presently claimed.

Applicant's arguments with respect to claims 7 and 8 have been considered but are deemed to be moot in view of the new grounds of rejection.

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Allowable Subject Matter

7. The prior art of record fails to show determining from said subscriber input when the first prompt message should be loaded onto a second voice message system. For this reason, claim 9 is allowed.

Regarding claim 17, the prior art of record fails to show in response to receiving said automatically generated E-mail message, accessing said voice message system by placing a telephone call to said voice message system over a telephone network.

As per claim 6, the prior art of record fails to show the combination of presented limitations.

8. Because the prior art of record does not teach the claimed forwarding device, claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O. A.

Olisa Anwah
Patent Examiner
November 16, 2005

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante